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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,198	02/13/2001	Frank D. Lortscher	05793.3027-00	8783

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EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant No.

09/781,198

Applicant(s)

LORTSCHER ET AL.

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/25/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-8, 12-19, 23-28, 32-37, 41-42, 57, 58-63, 65-71, 73-79 and 81- 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil et al. (US 5,987,440) in view of Goldhaber et al. (US 5,855,008).

O'Neil et al. teach a system and method for personal information security and exchange tool, comprising:

As per claims 1, 14, 23, 32 and 42,

- at least one database containing personal information provided by at least one user (column 2, lines 1-49; column 10, line 61 through column 11, line 9);
- at least one administrative agent for establishing access by subscribers to the personal information contained in the database based on preferences expressed by each user (column 2, lines 1-49; column 10, line 61 through column 11, line 9);
- at least one licensing agent for setting at least one licensing fee schedule for each user based on a set of licensing rules (column 23, lines 20-25; column 21, lines 37-62).

O'Neil et al. do not specifically teach that said personal information provided by at least one user is provided in response to an incentive offered to said user.

Goldhaber et al. teach a system and method for delivering positively and negatively priced information, wherein user provides personal information in response to an incentive offered to him (column 12, lines 49-61).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify O'Neil et al. to include that the user provides personal information in response to an incentive offered to him because it would allow subscribers to attract attention of users to their advertisement, thereby make the system more profitable.

As per claims 2, 12-13, 16, 25 and 34, O'Neil et al. teach said system and method, wherein the licensing agent determines the amount of payment to be made to each user (column 2, lines 56-63; column 10, line 61 through column 11, line 9; column 23, lines 20-25).

As per claims 3, 17, 26 and 35, O'Neil et al. teach said system and method, further comprising at least one payment agent for paying each user based on a set of payment rules the determined amount of payment (column 2, lines 56-63; column 10, line 61 through column 11, line 9; column 23, lines 20-25).

As per claims 6, 18, 27 and 36, O'Neil et al. teach said system and method wherein the set of licensing rules includes setting the licensing fee schedule such that a user receives a fixed percentage of all amounts received by an operator of the system from licensing the personal information related to that user (column 21, lines 37-62).

As per claims 7, 15, 24 and 33, O'Neil et al. teach said system and method wherein the database containing personal information includes financial information,

demographic information, psychometric information, or marketing information (Fig. 30; column 10, lines 17-60; column 17, lines 1-12).

As per claims 8, 19, 28 and 37, O'Neil et al. teach said system and method wherein the database containing personal information includes information concerning at least one user of the system from at least one third-party source of information (column 2, lines 49-55; column 6, lines 7-23).

As per claims 58-63, 66-71, 74-79 and 82-87, Goldhaber et al. et al. teach said system and method, comprising: creating an account for at least one of the potential users, wherein at least one on the potential users' response includes user preferences for access to the users' personal information (column 6, line 66 – column 7, line 11; column 12, lines 49-61).

As per claims 57, 65, 73 and 81, Goldhaber et al. et al. teach said system and method, comprising: determining a type of incentive to offer to each potential user (column 10, line 53 – column 11, line 15).

Claims 4-5, 9-11, 20-22, 29-31, 38-40, 43-46, 48-56, 64, 72, 80, 88 and 89-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil et al. and Goldhaber et al.

As per claims 4 and 5, O'Neil et al. teach said system and method comprising a customized Live Payment Server for performing transactions (column 21, lines 32-62).

However, O'Neil et al. do not specifically teach for depositing of fees into an Internet deposit account or designated bank account.

It would have been an obvious matter of design choice to modify O'Neil et al. and Goldhaber et al. to include any of an Internet deposit account or designated bank account, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of O'Neil et al. and Goldhaber et al. would perform the invention as claimed by the applicant with any form of payment or fee collection.

As per claims 9-11, 20-22, 29-31, 38-40, 43-44, 64, 72, 80, 88 and 89-94, O'Neil et al. and Goldhaber et al. teach all the limitations of claims 9-11, 20-22, 29-31, 38-40, 43-44, 64, 72, 80, 88 and 89-94, including providing a fee schedule mechanism, except that said fee schedule mechanism is a declining or increasing fee schedule mechanism.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The "offering an incentives" through "paying each of the users" steps would be performed the same regardless of what type of fee schedule mechanism is employed. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Also, as per claims 9-11, 20-22, 29-31, 38-40, 43-44, 64, 72, 80, 88 and 89-94, official notice is taken that the declining or increasing fee charging mechanism is well known in the art.

Therefor, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify O'Neil et al. and Goldhaber et al. to include the

declining or increasing fee schedule, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of O'Neil et al. and Goldhaber et al. would perform the invention as claimed by the applicant with any type of fee charging mechanism.

As per claims 45-47, 48-50, 51-53 and 54-56, O'Neil et al. and Goldhaber et al. teach all the limitations of claims 45-47, 48-50, 51-53 and 54-56, including that the incentive is offered to the at least one user (Goldhaber et al.; column 12, lines 49-61).

Goldhaber et al. do not teach specifics of the content of the incentive.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The "ofering an incentives" through "paying each of the users" steps would be performed the same regardless of the specifics of the content of the incentive. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Response to Arguments

Applicant's arguments with respect to claims 1-94 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

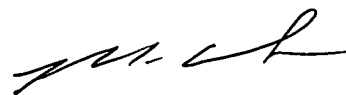
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or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



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